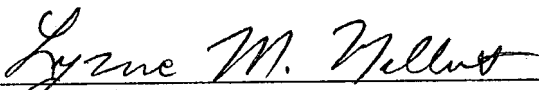


CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent & Trademark Office, Board of Patent Appeals and Interferences, at Facsimile No. 571-273-0299 on 31 October 2006.


Lynne M. Milliot

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Bart Alan MELTZER et al.

Application No. 09/173,858

Confirmation No. 4734

Filed: 16 October 1998

Title: **Documents for Commerce in Trading
Partner Networks and Interface
Definitions Based on the Documents**

Group Art Unit: 2178

Examiner: HUYNH, Cong Lac T.

CUSTOMER NO. 22470

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER RULE 183 FOR ORAL ARGUMENT ON REHEARING

Sir:

Have you ever tried, for a minute or two, to listen to programmers enthusiastically talking in abstractions about a new, unfamiliar programming construct? They might as well be speaking a foreign language. Even the familiar sounding words are used in a different way to fashion a new abstraction.

This case has moved so haltingly that counsel and the examiner might as well have been speaking different languages. The transaction history and IFW show that counsel has made every effort to work with the examiner and has escalated handling of the case slowly and reluctantly. During appeal, we even

worked with the Special Projects Examiner (SPRE) in TC 2100 to narrow the Rule 131 issues, leading to the supplemental brief filed September 22, 2005, which eliminated at least one extraneous issue on appeal.

This Board has studied the declarations and the art very closely. This thoughtful attention creates the opportunity to advance the case substantially and even to allowance. We do not want to lose the opportunity for lack of communication.

The posture of this case is extraordinary. It has been pending through many RCEs. On appeal, appellants won every argument that was briefed regarding the declarations that would remove McKendrick as a reference – the Board did not affirm on any grounds specified by the examiner and did not even mention the examiner's arguments regarding the declarations in its decision. Rehearing is prompted not by a close call on the merits, which we clearly favor removing the reference, but by the divergence between what the examiner argued and how the Board approached the same issue. Oral argument will expose appellant to grounds that the Board is considering relying on, including grounds not briefed, before the decision is set in writing.

Beyond this particular case, it will be worthwhile for the Board to understand how the declarations issue is perceived by various parts of the examining corps with whom we were in contact, so that it can give some guidance as to who, under the current MPEP, is supposed to address the issues presented by these declarations. We recognize that guidance may be given by the Board either in its opinion or through other channels. However, the opportunity to influence examination practice will be lost if we do not talk about how examination was handled.

As for the section 103 rejection, understanding arcane technology almost always presents extraordinary circumstances. Counsel tells inventors that writing a patent application requires spending less than a week to learn what the inventors spent multiple person-years developing and to describe it accurately. It is a rare disclosure in which counsel does not find and correct at least one minor mistake. For every application, counsel challenges the inventors to find mistakes

in counsel's draft, because the comprehension task is daunting. The Board's comprehension task is even more compressed: the Board has a few hours to review prosecution that has spanned years and sometimes finds the technology description in the briefs or record unsatisfying.

The technology in this case presents extraordinary circumstances because the Board's decision did not describe Web services, the claims or the reference as one of ordinary skill in the art would. We do not expect the Board to have a background in this technology, so we seek the opportunity to respond to questions orally that will give the Board a helpful grounding.

Oral argument will be especially important if the Board considers addressing any of these issues as a matter of waiver. We could have addressed each dependent claim separately, but that would have involved much more work for the Examiner and the Board during appeal. We relied on the rules and procedures for grouping claims, only to have the Board criticize us for not separately addressing the dependent claims. That cannot be considered waiver and, we argue in the request for rehearing, it is contrary to law.

Complete joinder of issues would be a beneficial result of oral argument. Counsel's approach will be more like an examiner interview than a Federal Circuit argument, because this is still a step in the examination process. Counsel recognizes, having earned his grey hair, that the opportunity for an oral argument to influence a decision depends on prompting the Board to ask questions and respond knowledgeably. We pledge to make this a productive oral argument, if our petition is granted.

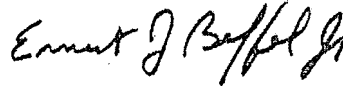
Therefore, appellants respectfully petition under Rule 183 for the Board and this panel to waive the rules and permit oral argument on rehearing. This request is based on the extraordinary circumstances described above, with the benefit of understanding the Board's arguments that cover different ground than the examiner picked.

Whether counsel appears in person, by video conference or by telephone will be determined if the petition is granted.

Fee Authorization. The Commissioner is hereby authorized to charge the petition fee required under 37 C.F.R. §1.17(f) of \$400 to Deposit Account No. 50-0869 (Atty Docket No. OIN 1004-1).

Conditional Fee Authorization. If this Petition is granted, the Commissioner is hereby authorized to charge the fee required for a request for oral hearing of \$1,000 to Deposit Account No. 50/0869 (Atty Docket No. OIN 1004-1).

Respectfully submitted,



Dated: 31 October 2006

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